

REMARKS

Reconsideration and allowance of all claims are requested.

Applicant appreciates the Interview courteously granted by Examiner Richale Lee Quinn to Meera Narasimhan on November 12, 2009. Applicant respectfully requests a call from the Examiner to resolve any informal issues that may remain to expedite allowance of this case.

The above amendments to the claims were discussed with the Examiner and particularly point out and distinctly claim the subject matter of the invention. Antecedence for all the amendments exists in the originally filed application. No new matter has been added by the amendments.

Claims 1 - 7, 9 - 11, and 13 - 22 are pending in the application.

Claims 1 – 4, 6, 7, 9-11, 13, 15, 16, and 20 are patentable under 35 U.S.C. 102(b) over Browder, Jr. (U.S. 6,276,175).

Applicant relies on, without repeating here, all the arguments of record, presented towards the patentability of the claims.

The present claims define a clothing article and a method for manufacturing the clothing article for persons with hernia. The clothing article exerts compression on the user's lower part of the body and has a predefined size and shape as it is formed as a seamless tubular item with an anatomic fit producing compression of between 15 to 50 mmHg within a previously selected area positioned on the abdomen area of the clothing article. The article provides an approximately constant compression within a certain range of users' sizes and shapes and the fabric comprises elastic yarns of elasthane between 15 and 60. The compression property provided by the present invention is suitable for hernia compression and unsuited for body shapers like that of Browder.

Browder discloses a product, e.g. an undergarment which contains at least one area of control, which has a stitch pattern which increases the modulus of the tubular knit fabric. Browder describes a product of common type which is used to provide control/support of different body parts, e.g. hips, waists and under a women's breast.

Browder seeks to contain all body parts as opposed to areas prone to hernia such as the abdomen of users. Browder therefore requires that the fabric over the stomach, waist, hips, and additional mid-riff areas as expressly taught by that reference.

It is apparent that Browder teaches away from the claimed invention and does not describe or teach or by inherency provide the claimed percentages of the compression areas. Thus, Browder is silent on the level of the compression and does not disclose the level of compression as claimed. For an invention to be anticipated, it must be demonstrated that each and every element of the claimed invention is present in the "four corners" of a single prior art, either expressly described therein or under the principle of inherency. *Lewmar Marine Inc. v Barient Inc.*, 3 USPQ2d 1766, 1767-1768 (Fed. Cir. 1987) (emphasis added). The absence from a prior art reference of any claimed element negates anticipation. *Kloster Speedsteel AB v. Crucible, Inc.*, 230 USPQ 81, 84 (Fed. Cir. 1986).

Therefore, independent Claims 1 and 9 are patentable over Browder at least because Browder does not teach compression of between 15 to 50 mmHg within a previously selected area of the clothing article, an approximately constant compression within a certain range of users' sizes and shapes, or elastic yarns used forming between 15 and 60% of the fabric, preferably between 30 and 50%, of the areas of the clothing article, which are to exert compression on the user's body. The Browder product is not capable of supplying a compression of between 15 to 50 mmHg or a constant compression within a range of user's sizes.

Furthermore, Browder does not teach or suggest anywhere the use of 15 to 60% elastic yarns. Column 2, lines 25-29, which are cited to by the Examiner in this regard, say nothing about the percentage of elastic yarns. Indeed, it is not possible to determine the percentage of elastic yarns based on the information provided in Browder. The use of a high elastic yarn percentage in the areas of the clothing article that exerts compression on the user's body is essential and novel. To be anticipating, a prior art reference must disclose "each and every limitation of the claimed invention[,]... must be enabling[,] and must describe...[the] claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention." *In re Paulsen*, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

As pointed out during the Interview, there is no basis in Browder for the Examiner's contention about the Browder fabric thickness. The office action, on page 4, last lines under the paragraph 2 rejection state that Browder teaches in column 4, line 5 that the elastic yarn has the claimed thickness and specifically states that Browder teaches "140 denier" yarn. However, Applicant has reviewed the entire Browder reference and does not find any support for such a contention.

Additionally, Applicant pointed out that Browder (column 3, lines 20-22) expressly teaches that the body 10 of flat nylon ground yarn is 40-120 denier which is 44.4-133.3 decitex. Also, the control area 25 (column 3, lines 32-34) is 70 denier which is 77.9 decitex. In column 5, lines 10-19, Browder provides that the nylon ground yarn body is 40-120 denier, preferably 80-120 denier which is 88.9 -133.3 decitex and that the control area is 20-40 denier, preferably 20 denier, which is 22.2-44.4 decitex, preferably 22.2 decitex. The present claims define ranges between 100-350 decitex or 250-450 decitex which is not taught or inherently provided by Browder. Thus, none of the features of these dependent claims are taught by Browder.

Claims 2 - 7, 10 - 11, and 13 depend from independent Claim 1 or 9 and add further patentable limitations. For at least the above reasons, the rejection of Claims 1 – 4, 6, 7, 9-11, 13, 15, 16, and 20 under 35 U.S.C. 102(b) over Browder is improper and should be withdrawn.

Claims 17, 18 , 21, and 22 are patentable under 35 U.S.C. 103(a) over Browder, Jr. (U.S. 6,276,175).

As pointed out above, Browder does not describe, teach or suggest the claimed invention. Therefore, Browder cannot anticipate nor render obvious any of the claimed features.

Even though Browder does not teach or suggest the claimed features (see above), the claims have been rejected as being obvious for no reason of record that could enable Applicant to adequately rebut the rejections. That [the prior art] might incorporate elements which could be used in appellants' system does not render appellants' claims obvious when there is no suggestion of using these elements in substantially the same manner as appellants use them. *In re Donovan*, 184 USPQ 414, 421 (CCPA, 1975).

Citing *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984), the court pointed out, "the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification". *In re Fritch*, 23 USPQ2d 1783, 1784 (Fed. Cir. 1992).

In any case Browder does not describe, teach or suggest the claimed invention as pointed out above and being relied on in the rebuttal of the rejections of claims 17, 18, 21, and 22.

Claim 5 is patentable under 35 U.S.C. 103(a) over Browder, Jr. (U.S. 6,276,175) in view of Sinigagliesi (U.S. 2,736,036).

Browder does not teach nor suggest the claimed invention. Therefore, any further combination with secondary references will also teach away from the present claims. Thus, Claim 5 is patentable under 35 U.S.C. 103(a) over Browder in view of Sinigagliesi.

Claim 5 depends from independent patentable Claim 1 and claim 3, and shares its patentable features and adds further patentable limitations. Claim 5 adds that groin area in the panty brief there is provided an aperture so that the user can relieve himself without taking off the panty brief.

Browder relates to torso control in women and Sinigagliesi relates to elastic drawers, with modifications of fly openings for male users. Moreover, Sinigagliesi teaches that the tubular knitted fabric has elastic thread spirally interlaced in the girdle portion only. That contradicts with the teaching of Browder that requires entire areas of elastomeric yarn with a 1x1 alternating tuck stitch for increasing the modulus by 8%. The two teachings are mutually contradictory. Obviousness is tested by what the combined teachings of the references would have suggested to those of ordinary skill in the art. It cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Teachings of references can be combined only if there is some suggestion or incentive to do so. *In re Fine*, 5 USPQ2d 1596, 1599 (Fed. Cir. 1988).

Therefore, one of ordinary skill in the art would be dissuaded from combining the two teachings, even if such combination is in hindsight reconstruction as has been done by the Examiner. "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered

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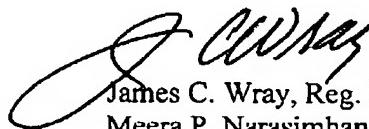
obvious." In re Fritch, 23 USPQ2d 1783, 1784 (Fed. Cir. 1992), quoting from In re Gorman, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991).

Nothing in Browder, with or without Sinigagliesi, teaches a desirability of the modification as effected by the Examiner. Therefore claim 5 is also patentable over the cited references.

CONCLUSION

Reconsideration and allowance of all claims are respectfully requested.

Respectfully,



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